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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,139	08/03/2001	Blair Winner	BAL6019P0331US	7439

32116 7590 09/23/2003

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
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CHICAGO, IL 60661

EXAMINER

PARA, ANNETTE H

ART UNIT PAPER NUMBER

1661

DATE MAILED: 09/23/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,139

Applicant(s)

WINNER, BLAIR

Examiner

Annette H. Para

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1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-16, 19-21 and 24 is/are allowed.
- 6) ☒ Claim(s) 17 18, 22, 23, 25-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

The amendment sent on April 8, 2003 has been entered.

#### Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitation "said seed". There is insufficient antecedent basis for this limitation in the claim.

#### Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

### Written Description

Claims 17, 22, 23, 25-31, and 32-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *"An applicant shows possession of the claimed invention by describing the claimed invention with all its limitations."* MPEP 2163. *"Possession may be shown in many ways. For example, possession may be shown by describing an actual reduction to practice of the*

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*claimed invention. Possession may also be shown by a clear depiction of the invention in detailed drawings or in structural chemical formulas which permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention.*" MPEP 2163. Applicants traverse this rejection stating that the specification as filed conveys to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Examiner disagrees and maintains the rejection. Claim 17 is drawn to F2 generation of hybrid seed. In the F2 generation, a natural hybrid breakdown begins to occur. No longer are the plants from the F2 seeds are the same as the hybrid describe in the specification. No longer can you be sure of plant vigor, high xanthophylls production, high flower-weight yield, male sterility and fully-double flowers.

Claims 22,23, 25-27 are drawn to a second-generation hybrid marigold produced by hybridization with any and all marigold plants. No such hybrids have been described. *"A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process."* MPEP 2163. *"The analysis of whether the specification complies with the written description requirement calls for the examiner to compare the scope of the claim with the scope of the description to determine whether applicant has demonstrated possession of the claimed invention....Generally, there is an inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement. Information which is well known in the art need not be described in detail in the specification."* MPEP 2163 Claim 28, 33-35 are drawn to a progeny of a marigold plant designated 50011 and its parts, which express trait selected from the group consisting of: high xanthophylls production, male sterility and fully double flowers. However, the specification only discloses the deposited seeds obtained from the marigold plant 50011. Claim 31 is drawn to a progeny having all the physiological or morphological characteristics of the marigold plant of claim13. "Or" leaves open possibility of some other plant not disclose in the specification. Applicants have described one or two characteristics, but many characteristics such as leaf size, ray floret morphology, etc., are not described, are unpredictable, and are expected to differ for every sexually produced progeny plant. *"The claimed invention as a whole may not be adequately described if the claims require an essential or critical*

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*feature which is not adequately described in the specification and which is not conventional in the art or known to one of the ordinary skill in the art. For example, consider the claim "A gene comprising SEQ ID NO:1." A determination of what the claim as a whole covers may result in a conclusion that specific structures such as a promoter, a coding region, or other elements are included. Although all genes encompassed by this claim share the characteristics of comprising SEQ ID NO:1, there may be insufficient description of those specific structures (e.g., promoters, enhancers, coding regions, and other regulatory elements) which are also included." MPEP2163*

In analyzing whether the written description requirement is met for genus claims, it is first determined whether a representative number of species have been described by their complete structure. (It is not realistic to expect that the "complete structure" of a plant, or even a cell, could be described. Therefore the inquiry required by this portion of the written description guidelines is interpreted to be whether the phenotype of the claimed plant has been described.) In this case, the one disclosed embodiment is not representative of the enormous number of products claimed. The claims encompass every marigold seeds or plants grown from the deposited seeds. Plants have many phenotype traits, which vary independently, so millions of possible phenotypes are possible and claimed. The specification discloses only the marigold plant 50011 and the deposited F<sub>1</sub> seeds but not the distinguishing characteristics of the embryos from these deposited seeds, and not the heterozygous population claimed. Next, then, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics. It is not possible to adequately describe the claimed products because the cross of hybrid plant gives raises of a heterozygous population. One skilled in the art would not have been able to predict all of the resulting phenotypes. The limited disclosure in the specification is not deemed sufficient to reasonably convey to one skilled in the art that Applicants were in possession of the huge genera recited in the claims at the time the application was filed. Thus it is concluded that the written description requirement is not satisfied for the claimed genera.

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### **Claim Rejections - 35 USC § 102/103**

Applicants' arguments filed on April 8, 2003 have been fully considered but they are not persuasive. Applicants argue that claim 28 is directed to a marigold plant wherein at least one ancestor of the marigold plant of claim 13 and plant capable of expressing at least one marigold plant 50011 trait: high xanthophylls production, male sterility and fully-double flowers. Applicants argue that the claimed plants are not anticipated or obvious in view of the Xanthophyll marigold production, because the publication does not disclose marigold plant 50011, and any of the trait such as high xanthophyll production, male sterility or fully-double flowers are disclosed or suggested in the publication. By stating that the claimed plant has 50011 in its lineage, applicants are essentially reciting a process for production of the claimed plant. Plants with high xanthophyll production are described in xanthophylls marigold production (entire document).

Claim 28 remains rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over PanAmerican Seed (Xanthophyll Marigolds).

### **Conclusion**

Claims 12-16, 19-21, 24, are allowed. Claims 17, 18, 22, 23, 25-35 are rejected.

### **Future Correspondence**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (703) 308-6327. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax numbers for the group are Before Final (703) 872-9306 and After Final (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 872-9305.

A.H.P

  
**CHRISTOPHER S. F. LOW**  
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